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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,761	03/22/2004	Tanna Marie Richardson	SLA1564	1251
<div>7590 12/10/2007</div> <div>Gerald W. Maliszewski P.O. Box 270829 San Diego, CA 92198-2829</div> <div>EXAMINER SHAN, APRIL YING</div> <div>ART UNIT 2135 PAPER NUMBER</div> <div>MAIL DATE 12/10/2007 DELIVERY MODE PAPER</div>				

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/805,761

Applicant(s)

RICHARDSON, TANNA MARIE

Examiner

April Y. Shan

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2007 and 24 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3, 4, 7, 8, 10, 12, 13 and 16-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 4, 7, 8, 10, 12, 13 and 16-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species 1 (Claims 1, 3-4, 7-8, 10, 12-13 and 16-18) in the reply filed on 24 September, 2007 is acknowledged. The Applicant further stated that Species II (Claims 9 and 19) is hereby cancelled.
2. A Request for Continued Examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2 July 2007 has been entered.
3. Claims 1, 4, 7-10, 13, 16 and 18-19 have been amended. Claims 2, 5-6, 9, 11, 14-15 and 19 are canceled. No new claims have been added. Claims 1, 3-4, 7-8, 10, 12-13 and 16-18 are currently pending in the present application.
4. Applicant's amendments and argument have been respectfully and fully considered, but are moot in view of new ground rejection as set forth below. It is noted that Applicant's arguments are directed towards limitations newly added via

amendments. Any well known art statements from the last office action not argued by the Applicant are taken as admittance of prior art as per MPEP 2144.03.

5. Any objections or rejections not repeated below for record are withdrawn due to Applicant's amendment to the claims and cancellations of the claims.

Claim Objections

6. Claims 1, 3-4, 7-8 are objected to because of the following informalities:

As per **claim 1**, "encrypting the scanned document creating an encrypted document" is being recited. However, this claim limitation is grammatically incomprehensible.

Any claim not specifically addressed, above, is being objected as incorporating the deficiencies of a claim upon which it depends.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
9. Claims 1, 3-4, 7-8, 10, 12-13 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw (U.S. Patent No. 6,542,261) in view of Chan et al. (U.S. Patent No. 6,378,070)

As per **claims 1 and 10**, McGraw discloses a method/system, comprising:

at a source, scanning a document ("The document to be sent via secure FAX in accordance with the present invention is scanned by the sender's FAX machine or other scanning device" - e.g. col. 2, lines 53-55);

accepting a password ("In general, the sender of the FAX enters a "code" into either a FAX machine's control panel or an associated computer which is running a secure FAX software package. The code is known by the intended recipient of the FAX..." - e.g. col. 2, lines 48-53. Please note a code corresponds to Applicant's password);

encrypting the scanned document creating an encrypted document ("The scanned data is encrypted via one of a variety of known encryption techniques...." - e.g. col. 2, lines 55-58); and,

transmitting a file including a header with an unencrypted identification of the encrypted document, and the encrypted document (e.g. col. 1, line 67 - col. 2, line 10, col. 2, line 59 - col. 3, line 18 and col. 6, lines 27-36), from the source to a

network-connected printer ("The secure FAX data (secure bit map and header) is sent as a normal FAX to a communication system 16. The communication system can be ...internet system or any communication system that can or is adopted to carry out a FAX transmission" - e.g. col. 3, lines 58-64, "The CPU 64, memory 68 and scanner may all be contained in a multifunction printer/scanner/FAX machine" – e.g. col. 4, lines 64-65, fig. 2 and FAX machine 30 is connected to communication system 16 in fig. 1. Please note internet system is the worldwide, publicly accessible network and therefore, FAX machine 30 is a network-connected printer)

at the printer, accepting the file from the source (e.g. col. 6, lines 34-53);

storing the encrypted document in printer memory until a user enters an access code (e.g. col. 5, lines 21-25, col. 5, lines 36-42);

accepting the access code from the user at a printer local interface (e.g. col. 6, lines 53-56);

in response to a matching the access code to the password, decrypting the encrypted document ; and printing the decrypted document (e.g. col. 6, lines 57-62).

McGraw further discloses in col. 6, lines 53-55 "In step S26, the user is queried for the code (decryption code) that must be used to decrypt the encrypted bit map/bit stream into a human readable document". Inherently, there must be some kinds of comparison step to verify the code is the correct code to decrypt the document.

Chan et al. discloses the file includes a password and comparing the access code to the password in the file ("...to transmit to the print server the document

accompanied by a first identifier for the intended recipient...comparing the second identifier with the stored first identifier..." - e.g. col. 2, lines 15-34). It would have been obvious to a person with ordinary skill in the art at the time of the invention to combine Chan et al.'s well known features of file includes a password and comparing the access code to the password in the file with McGraw since "Advantageously, a document is only printed when the intended recipient interacts with the printing apparatus in order to retrieve and print the previously-submitted document" (Chan et al., col. 2, lines 34-39)

As per **claims 3 and 12**, McGraw – Chan et al. discloses a method/system as applied above in claims 1 and 10. Chan et al. further discloses wherein accepting a password includes accepting a password selected from the group including a PIN number, an alphanumeric code, biometric data, Smart card, magnetic stripe card, and proximity badge (e.g. abstract and col. 2, lines 48-53).

As per **claims 4 and 13**, McGraw – Chan et al. discloses a method/system as applied above in claims 1 and 10. McGraw further discloses wherein encrypting the document includes: at the source, deriving an encryption key from the password; and, using the encryption key to encrypt the document (e.g. col. 1, lines 64-67 and col. 2, lines 47 - 58).

As per **claims 7 and 16**, McGraw – Chan et al. discloses a method/system as applied above in claims 1 and 10. Chan et al. further discloses comprising: at the source, hashing the password ("... This can be achieved using a message digest function such as the **Secure Hash Algorithm (SHA-1)**..." – e.g. col. 6, lines 15-28); at the printer, entering the access code and, wherein comparing the access code to the password includes comparing (e.g. col. 2, lines 15-34).

As per **claims 8 and 17**, McGraw – Chan et al. discloses a method/system as applied above in claims 1 and 16. McGraw further discloses wherein decrypting the document includes:

regenerating the encryption key from the access code; and,
using the encryption key to decrypt the encrypted document (e.g. col. 6, lines 53-56).

As per **claim 18**, McGraw – Chan et al. discloses a system as applied above in claim 11. Chan et al. further discloses wherein the printer user interface accepts an access code selected from the group including a PIN number, an alphanumeric code, biometric data, Smart card, magnetic stripe card, and proximity badge (e.g. abstract and col. 2, lines 48-53).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO – 892)


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

3 December 2007
AYS


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ELECTRONIC PATENT
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